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OFFICE OF PETITIONS

In re Application of	:	
Papenfuss et al.	:	
Application No. 10/689,478	:	ON APPLICATION FOR
Filed: 10/20/2003	:	PATENT TERM ADJUSTMENT
Atty Docket No.	:	
20717	:	

This is in response to the "PETITION UNDER 37 C.F.R. § 1.705," filed on August 10, 2010, which is treated as a petition under 37 CFR 1.705(b). Applicants request that the patent term adjustment be increased from 0 days to at least 832 days. Applicants request this correction in part on the basis that the Office will take in excess of three years to issue this patent.

To the extent the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected

issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

With regard to the request under 37 CFR 1.705(b), the application for patent term adjustment is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136.

On June 24, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 0 days (217 days of Office delay reduced by 318 days of applicant delay).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The subject application was timely filed on August 10, 2010.²

Applicants assert entitlement to an additional period of adjustment of 86 days for Office delay in connection with the reply filed on May 13, 2009. Specifically, on August 20, 2009, a non-final Office action was mailed in response to the reply filed on May 13, 2009. On December 8, 2009, however, the non-final Office action was withdrawn, and a new non-final Office action was mailed. Applicants assert entitlement to a period of adjustment because that the final Office action mailed on December 8, 2009, was mailed four months and 86 days after day the date the reply was filed on May 13, 2009.

35 U.S.C. 154(b)(1)(A)(i) provides that:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

37 CFR § 1.702 provides that:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

² A review of Office PALM records indicates that the issue fee was paid on September 2, 2010.

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

Applicants' arguments and evidence have been considered, but have not been found persuasive. Pursuant to 35 U.S.C. 154(b)(1)(A)(i)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the failure of the Office to respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken. In this regard, the Office did respond within four (4) months to petitioner's amendment filed on May 13, 2009, by issuing the Office action mailed on August 20, 2009. The fact that the outstanding Office action was withdrawn and a new Office action was mailed on December 8, 2009, does not alter the fact that the Office did respond to the reply within 4 months after the date on which the reply was filed.

Thus, it is concluded that, in this instance, the withdrawal of the Office action mailed on August 20, 2009, and the mailing of a new action under 35 U.S.C. 132 on December 8, 2009, did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

In view thereof, no change to the patent term adjustment at the time of mailing of the notice of allowance is warranted; the petition is **DISMISSED**.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Data Management has been advised of this decision. The application is thereby forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and if applicable, for the Office taking in excess of three years to issue the patent (to the extent that the

three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.

A handwritten signature in black ink, appearing to read "D Wood", with a long, sweeping horizontal stroke extending to the right.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions